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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/916,485 | 07/30/2001 | Ulrich Gerber | 003780-060 | 8847 |

7590

03/23/2004

William L. Mathis
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

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| EXAMINER |
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OH, TAYLOR V

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| ART UNIT | PAPER NUMBER |
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1625

DATE MAILED: 03/23/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,485

Applicant(s)

GERBER ET AL.

Examiner

Taylor Victor Oh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-18, 20-22 and 24 is/are rejected.
- 7) ☒ Claim(s) 19 and 23 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Applicant's arguments with respect to claims 1-8 and 10-24 have been considered but are moot in view of the new ground(s) of rejection.

The Status of Claims :

Claims 1-8 and 10-24 are pending.

Claim 9 has been withdrawn.

Claims 1-8 ,10-18, 20-22, and 24 have been rejected.

Claims 19 and 23 have been objected.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8, 18, 20-21, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1-8, and 18 , the claimed compounds of formula (I) has the description of various substituents, R₁, R₂ ,R₃ ,R₄, and R₅ . However, each of the corresponding limitations is not clearly specified ; as a result, the claimed compounds are extremely uncertain without any defined carbon atom range. The claimed formula is vague and indefinite. Therefore, An appropriate correction is required.

In claims 1, 20-21, and 24, the phrases “ polyester polyols comprising”, “cyclic 1,2-dicarboxylic anhydride comprises”, and “polyol comprises” are recited. The expression of the term “comprising” or “comprises” is vague and indefinite. The meaning of “ polyester polyols comprising” would mean many additional compounds besides the polyester polyols; the meaning of “cyclic 1,2-dicarboxylic anhydride comprises” would mean many additional compounds besides the cyclic 1,2-dicarboxylic anhydride; and the meaning of “polyol comprises” would mean many additional compounds besides the polyol. An appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 and 10-18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated clearly by Kawai et al (JP10330470).

Kawai et al discloses the fatty acid-modified polyester polyol composition is obtained by reacting an 8-30 carbon fatty acid and a phthalic anhydride with an ethylene glycol (see a front page of abstract). Furthermore, according to Table 1 (see page 4 on the translated copy of JP10330470), there are seven examples (A-G), In EX.

A, 38 g of castor oil ,which has a main component of ricinoleic acid of carbon , 4262 of terephthalic acids , ethylene glycol 335g, and catalyst are reacted at temperature of 200 to 230⁰ C. and dehydrated under a nitrogen gas (see page 3 on the translated copy of JP10330470, lines 20-26) ; furthermore, in Ex. C, the use of phthalic anhydride is described instead of terephthalic acids for making the polyester polyol C (see page 3 on the translated copy of JP10330470, lines 20-26). In addition the hydroxyl equivalent can be 242 according to EX. F (Table 1). This is identical with the claims.

Claims 19 and 23 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mckane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/19/04



BA K. TRINH
PRIMARY EXAMINER
GROUP 1200-1625